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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/076,115 05/12/98 GRUBER

C 0942.4350001

KM

HM12/0523

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EXAMINER

TUNG, J

ART UNIT

PAPER NUMBER

1656

DATE MAILED:

05/23/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/076,115

Applicant(s)

Gruber et al

Examiner

Joyce Tung

Art Unit

1656



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 3/12/01

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31, and 32 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31, and 32 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20

20) ☐ Other:

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Response to Amendment

1. The amendment file 3/12/2001 has been entered.
2. The rejection of claims 41-43 under 35 U.S.C. §102(e) is withdrawn because of the amendment.
3. The rejection of claims 6, 20 and 32 under 35 U.S.C. §112, second paragraph is withdrawn because of the amendment.
4. Regarding the rejection of claims 1,2, 6, 12, 16-20, 22, 25, 28, 29, 31 and 32 under 35 U.S.C. §103(a) over Burmer in view of Carninci et al., the response argues that Burmer does not disclose using primer-adaptor molecules to produce a product nucleic acid molecule. Burmer does disclose that the method involves using an adaptor which includes a restriction site and a ligand binding end ligated to the nucleic acid fragment of a first and second nucleic acid samples to provide the nucleic acid complementary to a primer for amplification (see column 4, lines 16-25). This suggests that the primer comprises the nucleic acid sequence which is complementary to the adaptor which includes a restriction site and a ligand binding end. The isolation step is done by first removing the adaptors by restriction enzyme, capturing the nucleic acid containing the ligand and then the nucleic acid that were not captured is isolated (see column 2, lines 56-59). Thus, one of skill in the art at the time of the instant invention would have been motivated to design the primer-adaptor as claimed to make the instant invention.

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The response further argues that the deficiencies of Burmer are not cured by the disclosure of Carninci in which Carninci et al. do not suggest using primer containing both cleavage sites and ligands. Carninci et al. disclose that the method involves using a primer inserted with restriction sites, the restriction sites are incorporated into cDNA by PCR with ExTaq DNA polymerase and the amplified nucleic acid is cleaved by the restriction enzyme (see pg. 329, column 1-2, the fourth and fifth paragraph). Thus, one of skill in the art at the time of the instant invention would have been motivated to combine the teachings of Burmer and Carninci et al. to design the primer-adaptor as claimed to make the instant invention. Therefore, the rejection is maintained.

5. Claims 1, 2, 6, 12, 16-20, 22, 25, 28, 29, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burmer (5,726,022) in view of Carninci et al. (Genomics, 1996, Vol. 37, pg. 327-336).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached at (703) 308-1152.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

Joyce Tung
May 11, 2001



EGGERTON A. CAMPBELL
PRIMARY EXAMINER